

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 1, 9 and 17 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1, 4-9, 12-17 and 20-24 are pending and under consideration. Reconsideration is respectfully requested.

REJECTION UNDER 35 U.S.C. §103:

A. In the Office Action, at pages 3-5, numbered paragraphs 8-11, claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson [SinaNet] and further in view of Aiba et al. (USPN 5,428,458; hereafter, Aiba). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

For clarity, independent claim 1 has been amended to recite: "An electronic mail apparatus comprising: a storing unit storing information in response to a destination of an electronic mail, the information indicating whether a sentence to be included in the electronic mail is text-displayable based on text data on the basis of a character code system used at the destination of the electronic mail; a judging unit judging whether to form an image data of a text file corresponding to the sentence based on the information stored in said storing unit; an image data forming unit, when said judging unit judges that the image data of the text file corresponding to the sentence should be formed, to form the image data of the text file corresponding to the sentence; and a transmission unit transmitting the electronic mail with the formed image data of the text file corresponding to the sentence to the destination of the electronic mail." Independent claims 9 and 17 have been amended in similar fashion.

As noted by the Examiner, Jackson does not explicitly teach judging whether to form an image data of the sentence based on the information read out from the storing unit and reading information... In addition, we submit that Jackson does not teach the invention of amended claims 1, 9 and 17 (see above).

It is respectfully submitted that the invention of Aiba is directed to solving the problem of, in a facsimile apparatus, lack of resolution of image data wherein transmitted data may be transmitting code data (i.e., text) or image data (such as pictures)(col. 1, lines 22-42). That is, the invention of Aiba is not utilized to determine a selection of whether to print image data or code data, but rather is utilized to improve resolution of an image obtained from the image data. Aiba does not teach changing a text file to an image file when the text file is not text-displayable,

as is recited in the present claimed invention.

In contrast, the present claimed invention does not teach distinguishing between text and images, but rather is used to determine whether a sentence (text) is text-displayable, and if the sentence (text) is not text-displayable (such as when the sentence is written in a foreign language such as Japanese), a text file corresponding to the sentence is converted to a bit map file (image file) and the bit map file is transmitted to the destination of the electronic mail.

Thus, it is respectfully submitted that amended claims 1, 9 and 17 are patentable under 35 U.S.C. §103(a) over Jackson [SinaNet] and further in view of Aiba et al. (USPN 5,428,458) Since claims 4, 8, 9, 12, 16, 20, and 24 depend from amended claims 1, 9 and 17, respectively, claims 4, 8, 9, 12, 16, 20, and 24 are submitted to be patentable under 35 U.S.C. §103(a) over Jackson [SinaNet] and further in view of Aiba et al. (USPN 5,428,458) for at least the reasons that amended claims 1, 9 and 17 are submitted to be patentable under 35 U.S.C. §103(a) over Jackson [SinaNet] and further in view of Aiba et al. (USPN 5,428,458).

B. In the Office Action, at pages 5-8, numbered paragraphs 12-15, claims 5-7, 13-15, and 21-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson [SinaNet] and further in view of Aiba et al. (USPN 5,428,458; hereafter, Aiba) as applied to claims 1, 4, 8, 9, 12 16, 17, 20 and 24 above, and further in view of Flanagan et al. (as previously cited; hereafter, Flanagan). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

The Examiner admits that neither Jackson nor Aiba explicitly teaches translating the sentence into a language used in the destination when the sentence is expressed by characters written in a language different from the language used in the destination of the electronic mail, wherein the translation results are transmitted to the destination of the electronic mail.

As noted above, it is respectfully submitted that amended claims 1, 9 and 17 are patentable under 35 U.S.C. §103(a) over Jackson [SinaNet] and further in view of Aiba et al. (USPN 5,428,458). Since claims 5-7, 13-15 and 21-23 depend from amended claims 1, 9 and 17, respectively, claims 5-7, 13-15 and 21-23 are submitted to be patentable under 35 U.S.C. §103(a) over Jackson [SinaNet] and further in view of Aiba et al. (USPN 5,428,458) for at least the reasons that amended claims 1, 9 and 17 are submitted to be patentable under 35 U.S.C. §103(a) over Jackson [SinaNet] and further in view of Aiba et al. (USPN 5,428,458).

Flanagan (USPN 5,966,685) teaches translating messages received in different languages. In contrast, the present invention recites an electronic mail apparatus comprising: a storing unit storing information in response to a destination of an electronic mail, the information indicating whether a sentence to be included in the electronic mail is text-displayable

based on text data on the basis of a character code system used at the destination of the electronic mail; a judging unit judging whether to form an image data of a text file corresponding to the sentence based on the information stored in said storing unit; an image data forming unit, when said judging unit judges that the image data of the text file corresponding to the sentence should be formed, to form the image data of the text file corresponding to the sentence; and a transmission unit transmitting the electronic mail with the formed image data of the text file corresponding to the sentence to the destination of the electronic mail. determining whether to form image data of a text file corresponding to a sentence (see above) rather than translation, which is not taught or suggested by Flanagan.

Aiba was filed on November 10, 1994 based on a continuation of Ser. No. 7,105 filed January 21, 1993 and was published as U.S. Patent No. 5,428,458 on June 27, 1995, Jackson was published on June 29, 1998, and Flanagan was filed on November 8, 1996 based on a continuation of application No. 08/388,630 filed on February 14, 1995 and was published as U.S. Patent No. 5,966,685 on October 12, 1999. Since U.S. applications only began to be published on March 15, 2001, Aiba became publicly available on June 27, 1995, and Flanagan became publicly available on October 12, 1999, i.e., after the Jackson publication. Hence, it is respectfully submitted that the invention of Flanagan could not logically have been combined with Jackson because Flanagan was not available to the public at the time Jackson was published. Similarly, Flanagan could not logically have been combined with Aiba, since Flanagan was filed on February 14, 1995, i.e., prior to the publication of Aiba on June 27, 1995.

Thus, there can be no teaching or suggesting of combining Jackson [SinaNet], Aiba et al. and Flanagan et al. Hence, it is respectfully submitted that amended claims 1, 9 and 17 are patentable under 35 U.S.C. §103(a) over Jackson [SinaNet], Aiba et al. (USPN 5,428,458) and/or Flanagan (USPN 5,966,685). Since claims 5-7, 13-15 and 21-23 depend from amended claims 1, 9 and 17, respectively, 5-7, 13-15 and 21-23 are submitted to be patentable under 35 U.S.C. §103(a) over Jackson [SinaNet], Aiba et al. (USPN 5,428,458) and/or Flanagan (USPN 5,966,685) for at least the reasons that amended claims 1, 9 and 17 are submitted to be patentable under 35 U.S.C. §103(a) over Jackson [SinaNet], Aiba et al. (USPN 5,428,458) and/or Flanagan (USPN 5,966,685).

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date:

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